



Attorney Docket No.: 23091/24 (ACT-180) *DAC* #8

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

APPLICANTS: Mindaugas F. Dautartas and Dan A. Steinberg

EXAMINER: Unknown GROUP: 2811

SERIAL NO.: 10/066,299 CONFIRMATION NO: 2059

FILED: January 31, 2002

FOR: *Optoelectronic Submount Having an On-Edge Optoelectronic Device*

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CERTIFICATE OF MAILING

I hereby certify that this paper (along with any paper referred to as being attached or enclosed) is being deposited with the United States Postal Service on the date shown below with sufficient postage as first class mail in an envelope addressed to: BOX DAC, Assistant Commissioner for Patents, Washington, DC 20231 on:

By:

Deborah Celeste
Deborah Celeste

February 10, 2003
Date

BOX DAC
Assistant Commissioner for Patents
Washington, DC 20231

REQUEST FOR RECONSIDERATION OF
PETITION UNDER 37 CFR 1.47 (a)

Sir:

This is in response to the Decision Refusing Status Under 37 CFR 1.47(a) (a copy of which is enclosed), dated December 9, 2002.

Enclosed are two executed Declarations (seven pages) in compliance with 35 U.S.C. §§ 115 and 116.

Applicants request that the application be dispatched to an examining group.

Please charge any required fee for this response to Deposit Account No. 50-0369.

Respectfully submitted,

Maria Eliseeva

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Dated: February 3, 2003

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OFFICE OF PETITIONS

In re Application of
Dautartas, et al.
Application No. 10/066,299
Filed: January 31, 2002
Atty. Dkt. No. ACT-180
For: OPTOELECTRONIC SUBMOUNT
HAVING AN ON-EDGE OPTOELECTRONIC
DEVICE

DECISION REFUSING STATUS
UNDER 37 CFR 1.47(a)

This is in response to the petition under 37 CFR 1.47(a), filed August 26, 2002.

The petition is hereby DISMISSED.

Rule 47 applicant is given **TWO MONTHS** from the mailing date of this decision to reply, correcting the below-noted deficiencies. Any reply should be entitled "Request for Reconsideration of Petition Under 37 CFR 1.47(a)," and should only address the deficiencies noted below. Failure to respond will result in abandonment of the application. Any extensions of time will be governed by 37 CFR 1.136(a).

The above-identified application was filed January 31, 2002 without an executed oath or declaration and naming Mindaugas F. Dautartas and Dan A. Steinberg as joint inventors. Accordingly, on March 19, 2002, a Notice to File Missing Parts of Nonprovisional Application ("Notice") was mailed, requiring an executed oath or declaration and surcharge.

A grantable petition under 37 CFR 1.47(a) requires: (1) proof that the non-signing inventor cannot be reached or refuses to sign the oath or declaration after having been presented with the application papers (specification, claims and drawings); (2) an acceptable oath or declaration in compliance with 35 USC §§ 115 and 116; (3) the petition fee; and (4) a statement of the last known address of the non-signing inventor.

The instant petition lacks items (1) and (4) set forth above.

As to item (1), petitioner has failed to establish that the inventor received the application papers (specification, claims, drawings, and oath or declaration) and thereafter refused to execute the oath or declaration.

While petitioner indicates the inventor has verbally refused to sign the declaration, petitioner has provided no evidence that the inventor ever in fact received the application papers (specification, claims, drawings, and oath or declaration).

Petitioner is reminded that before a refusal to sign an oath or declaration can be alleged, it must be demonstrated that a *bona fide* effort has been made to present a copy of the application papers (specification, including claims, drawings, and oath or declaration) to the non-signing inventor. Petitioner has presented no evidence that the non-signing inventor was ever presented with a copy of the application papers (specification, claims, drawings, oath or declaration) for the instant application. While petitioner references a verbal refusal to execute a declaration, there is no indication that the inventor ever received the application papers

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and thereafter refused to execute the declaration.

Any renewed petition should be accompanied by evidence to sufficiently establish that the non-signing inventor either cannot be located or that the non-signing inventor was sent a complete copy of the application papers and thereafter refused to execute the declaration. A copy of the application papers should be sent to the last known address of the non-signing inventor, or, if the non-signing inventor is represented by counsel, to the address of the non-signing inventor's attorney. Petitioner may wish to provide the Office copies of letters sent to the inventor indicating the enclosure of the application papers (specification, claims, drawings, and oath or declaration). If after the inventor receives the application papers and requests to execute the oath or declaration are refused, these facts should be set forth in a statement of facts signed by the person to whom the refusals were made and detailing with specificity the exact manner of the refusals. If a written refusal has been made, a copy of the written refusal should be included on renewed petition.

As to item (4), petitioner has failed to include a statement of last known address of the non-signing inventor.

As to item (3) set forth above, the required petition fee has been charged to deposit account No. 50-0369 as authorized in the instant petition.

There is no indication that petitioner herein was ever empowered to prosecute the instant application. If petitioner desires to receive future correspondence regarding this application, the appropriate power of attorney documentation and change of correspondence address must be submitted. A courtesy copy of this decision will be mailed to petitioner; however, all future correspondence will be directed to the address of record unless the Office is notified otherwise in writing.

Further correspondence with regard to the petition under 37 CFR 1.47(a) should be addressed as follows:

By mail: Commissioner for Patents
 Box DAC
 Washington, D.C. 20231

By fax: (703) 308-6916
 Attn.: Office of Petitions

By hand: Crystal Plaza Four, Suite 3C23
 2201 S. Clark Place
 Arlington, VA

Telephone inquiries regarding this decision should be directed to the undersigned at (703) 305-0310.

Alesia M. Brown
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Petitions Attorney
Office of Petitions
Office of the Deputy Commissioner
for Patent Examination Policy

CC: MARIA M. ELISEEVA
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